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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,771	02/05/2002	Charles Eldering	T742-10	7576

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
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EXAMINER	
HUYNH, SON P	
ART UNIT	**PAPER NUMBER**
2623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/068,771	ELDERING ET AL.	
	Examiner	Art Unit	
	Son P. Huynh	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 November 2005 and 22 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *194,197-200,202 and 213-233* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *194,197-200,202 and 213-233* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review.(PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 194, 197-200, 202, 213-233 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-193, 195-196, 201, 203-212 have been cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 194, 197-200, 202, 213-233 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 6,463,585), in view of Makofka (US 2003/0037330), and further in view of Unger (US 6,909,837).

Regarding claim 194, Hendricks discloses a method for delivering targeted advertisements to a subscriber with video that the subscriber selected to receive from a television delivery system (col. 3, line 48-col. 4, line 5), the method comprising:

selecting the video (selecting a program carried in program channel – col. 9, lines 5-20, col. 17, lines 15-35);

determining available advertisement opportunities in the selected video (e.g, determining "pods", breaking time, etc. in the program – col. 5, lines 30-60, col. 27, lines 16-38);

selecting one or more targeted advertisements desired to be displayed to the subscriber, wherein the targeted advertisements correspond to the available advertisement opportunities (selecting targeted advertisements desired to be displayed to the subscriber, wherein the targeted advertisement correspond to "pod", break timing, feeder channel availability, user demographic and user geographic (col. 26, line 14-col. 27, line 67);

delivering the selected video and the targeted advertisements to the subscriber (col. 26, line 14-col. 27, line 67);

presenting the selected video and the targeted advertisement to the subscriber on a viewing device (displaying selected program and displaying targeted advertisement during program break – col. 15, line 60-col. 16, line 12). Hendricks further discloses presenting alternate commercial, promotion, advertising (col. 26, lines 14-30). However, Hendricks does not specifically disclose, presenting, upon detection of a fast-forward or skip operation of the targeted advertisement, an alternative advertisement, as a partial

screen display in conjunction with the fast-forwarded or skipped advertisement, wherein the alternative advertisement and the fast –forwarded or skipped targeted advertisement are simultaneously presented to the subscriber and wherein the alternative advertisement is for a product or service directly related to the product or service of the targeted advertisement.

Makofka discloses presenting, during trick play modes (include pause, scan forward, scan backward, jump, still frame display and the like – paragraphs 0009, 0021), advertising material 30, as a partial screen display in conjunction with the program material 20, wherein the program material are simultaneously presented to the subscriber (e.g. during trick play modes, the advertising material 30 can be displayed over the programming material 20 such that the programming material is partially visible underneath the advertising material 20, or the advertising is displayed with the programming material in a picture-in-picture format, or the advertising material being displayed as one of a banner or a border – see include, but is not limited to, paragraph 0024); the advertising material 30 may be associated with the program material being viewed (paragraphs, 0021 0027). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks to use the teaching of presenting, during trick play modes, program material as partial screen display in conjunction with the program material, the program material and the advertising material are simultaneously presented to the subscriber as taught by Makofka in order to allow user to simultaneously view different materials on the screen. However, Hendricks in view of Makofka does not explicitly discloses advertising material

is presented upon detection of a fast forward or skip operation of the programming material; the advertising material is for a product or service directly related to the product or service of the programming material.

Unger discloses presenting, upon detection of a fast-forward or skip operation of the targeted advertisement, an alternative advertisement (upon detecting past forward operation of the commercial during commercial breaks, presenting a tagged frame as a still image or playing the series of tagged frames at normal speed as a condensed video clip – col. 2, line 45-col. 3, line 39; col. 5, lines 10-25, lines 33-62); wherein alternative advertisement is for a product or service directly related to the product or service of the targeted advertisement (tagged frames or series of tagged frames are frames of the commercial being fast forwarded such as a picture of the product being advertised, etc.– col. 3, line 64-col. 4, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks in view of Makofka to use the teaching as taught by Unger in order minimize the interruption to the programming caused by interspersed commercial messages, while also protecting the broadcaster's source of revenue by providing the advertiser with a means of reaching potential customers with, at least, an abbreviated advertising message (col. 2, lines 35-42).

Regarding claim 197, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Makofka further discloses advertising material

display over (superimposed over) the programming material (see include but is not limited to, paragraph 0025).

Regarding claim 198, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Unger further discloses the alternative advertisement is a compressed version of the target advertisement (tagged frame/frames as static image or condensed video clip of the commercial being fast-forwarded – col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-54).

Regarding claim 199, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Hendricks further discloses selection of the target advertisement is based on a subscriber profile (see including, but is not limited to, col. 4, lines 35-42).

Regarding claim 200, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 199. Hendricks further discloses the subscriber profile defines trails associated with the subscriber, household demographics, traits associated with the selected video, or trails associated with previous selected videos (see including, but is not limited to, col. 4, lines 35-42).

Regarding claim 202, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Unger further discloses the alternative

advertisement (tagged frame/frames) is derived from the targeted advertisement (tagged frame/frames are portion (abbreviated commercial message) of full length commercials –col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-53).

Regarding claim 213, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Unger further discloses the alternative advertisement includes one or more video segments from the targeted advertisement (i.e. a frame or series of frames of the full length commercials – col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-53; figure 4).

Regarding claims 214-216 and 218, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Makofka further discloses the partial screen display is an overlay, a split-screen, a picture-in-picture, a computer graphic (banner or a border) (see include, but is not limited to, paragraph 0025).

Regarding claim 217, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Neither reference discloses partial screen display is a bug. Official Notice is taken that using partial screen display as a bug is well known in the art. For example, displaying commercials, logo, weather information, etc. on partial screen as a bug. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks in view of

Makofka and Unger to use the well-known teaching of display a bug in the art in order to minimize interfering of other data on the main screen.

Regarding claim 219, Hendricks in view of Makofka and Unger teaches a method as discussed in the rejection of claim 194. Unger further discloses the commercial messages with abbreviated advertising messages are provided to potential customer (col. 2, lines 40-42). It is obvious to one of ordinary skill in the art to target alternative advertisement to the subscriber in order to improve efficiency in advertising.

Regarding claim 220, the limitations that correspond to the limitations of claim 194 are analyzed as discussed in the rejection of claims 194 and 198.

Regarding claims 221-223, 225-231, 233, the additional limitations as claimed correspond to the additional limitations as claimed in claims 197, 199-200, 202, 213-218, 219 respectively, and are analyzed as discussed with respect to the rejection of claims 197, 199-200, 202, 213-218, 219.

Regarding claim 224, Hendricks in view of Makofka and Unger discloses a method as discussed in the rejection of claim 220. Unger further discloses the alternative advertisement (i.e. company logo or name of commercial being fast-forwarded) is not directly related to the targeted advertisement (the commercial being fast forwarded – see col. 5, lines 53-56).

Alternatively, Makofka discloses the advertising material may be unrelated to the program material (paragraph 0026).

Regarding claim 232, Hendricks in view of Makofka and Unger discloses a method as discussed in the rejection of claim 220. Unger further discloses the static frame (alternative advertisement) including, for example, a company logo or name, a picture of product being advertised, a celebrity endorser, etc. (col. 5, lines 50-62). Makofka also discloses the advertising material may be unrelated to the programming material (paragraph 0026). It is obvious to one of ordinary skill in the art that the alternative advertisement is directed to a product or service unrelated to the product or service of the targeted advertisement in order to provide a unrelated/different product/service to the user thereby increase chance for user to purchase the product.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Slezak (US 6,006,257) discloses multimedia for interactive advertising in which secondary programming is varied based upon viewer demographics programming.

Zigmond et al. (US 6,698,020) discloses techniques for intelligent video ad insertion.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh

January 5, 2007

CHRIS S. KELLEY
SUPERVISORY PATENT EXAMINER
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